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09/018,279	02/04/1998	BRIAN LEE KLOSTERMAN	014774-00315	9537

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EXAMINER

BROWN, RUEBEN M

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/018,279

Applicant(s)

KLOSTERMAN ET AL.

Examiner

Brown M. Reuben

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 01 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 32-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 32-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 4/1/2002 have been fully considered but they are not persuasive. Applicant traverses the 102 rejection of Bacon applied to claims 41 & 60, because "Bacon does not anticipate at least the second element of claim 41", as stated on page 11. Examiner respectfully disagrees with applicant's assertion. Applicant goes on to point out that claim 41 requires, "...receiving executable software associated with at least one of said downloadable features... wherein said executable software includes an identifier indicating specific receiving locations of said multiple receiving locations".

Applicant goes on to argue on page 12, that "in contrast Bacon, et al. describes a Reprogrammable Subscriber Terminal having a software present in a terminal, in which the state of the software is identified for upgrade purposes... In contrast applicant identifies each terminal with a location identifier". Examiner agrees with applicant that Bacon identifies the configuration of a terminal in order to determine whether a control program should be changed from the headend, see Abstract. Nevertheless, Bacon also identifies which particular subscriber terminal will receive software code; see col. 5, lines 59-62.

Examiner points out that this feature is entirely consistent with the disclosure of Bacon and is met by the cited reference. In particular, Bacon discloses that transactions in the system

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are designated as addressed (to a particular subscriber terminal or group of subscriber terminals) and global (to all subscriber terminals), col. 5, lines 59-64. The disclosed transactions refer to the downloading of executable software code, as recited in the instant claims. Therefore it is clear that Bacon teaches identifying the subscriber terminals, which receive a particular download of software, either individually or within a group.

Furthermore, Bacon discusses that the use of the very well known subscriber addressing technology efficiently and accurately downloads program code into the memory space of a particular one or more subscriber terminals. It is taught that “by having the download parameters transaction either addressed or global, internal or external, the system allows for efficient addressing of the program code to either all, **a group of terminals or even a single terminal.**”, emphasis added, (col. 10, lines 51-58). Therefore examiner maintains the previous rejection of the claims based upon Bacon.

The amendment added to claim 60, of multiple “uniquely identified” receiving locations is also met by the disclosure of Bacon, (col. 5, lines 59-64 & col. 10, lines 51-58). Despite the arguments to the contrary, Bacon specifically discloses transmitting particular software to particular subscriber terminals, either within a group or individually. This technique inherently requires that each of the subscriber terminals are uniquely identified, since they may be individually addressed.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 41-45, 60-63, 66-69 & 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Bacon, (U.S. Pat # 5,440,632).

Considering claims 41 & 60, Bacon discloses a TV system with downloadable features comprising multiple receiving locations, see Abstract & Fig. 1. As for the claimed computer storage device associated with the receiving location, which retrieves executable software associated with at least one of the downloadable features from computer readable storage

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medium, is met Bacon, col. 9, lines 25-35 & col. 12, lines 51-65. Bacon also includes a memory associated with each of the computer storage devices for storing retrieved executable software and a microprocessor, see col. 7, lines 50-67; col. 8, lines 22-50.

Considering claims 42-45, see Bacon, Fig. 1; Fig. 2; col. 7, lines 39-50 & col. 8, lines 1-12.

Considering claim 61, Bacon teaches that downloadable data may be transmitted over in-band data channels, col. 2, lines 16-25 & col. 5, lines 25-45.

Considering claim 62, see Bacon, col. 11, lines 31-41.

Considering claim 63, see Bacon col. 13; col. 14, lines 1-64.

Considering claim 66, the claimed elements of a TV system receiving locations comprising a data receiver corresponds with subject matter mentioned above in the rejection of claim 41, and is likewise analyzed. Claim 66 includes the feature of the memory storing system-operating software, which is met by Bacon, col. 3, lines 5-45.

Considering claim 67, the claimed elements of a TV system receiving locations comprising a data receiver corresponds with subject matter mentioned above in the rejection of claim 41, and is likewise analyzed. Claim 67 includes the feature that an IR code is assigned for

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a remote control. In Bacon, IR codes for a remote control are assigned which enables the instant remote control to interact with the subscriber terminal.

Considering claim 68, the claimed elements of a TV system receiving locations comprising a data receiver corresponds with subject matter mentioned above in the rejection of claim 41, and is likewise analyzed. Claim 66 includes the feature of including information about the feature which enables a user to choose whether, have the feature downloaded, which reads on col. 11, lines 12-20 & col. 16, lines 14-40.

Considering claims 69 & 71, Bacon discloses all subject matter except that a downloaded feature is already present and enabled. Bacon discloses that software upgrades are downloaded to subscriber terminals, which would require that the feature is already present at the instant subscriber terminal, col. 2, lines 40-50. As for the claimed of non-enabled features, Bacon teaches that authorization codes are transmitted, which are used to enable a particular terminal to operate disabled programming, e.g. due to encryption or scrambling, col. 8, lines 25-26.

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*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32-40, 46-59, 64-65 & 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacon, in view of Isenberg, (U.S. Pat # 5,570,295).

Considering claims 32, 46, 54, 64 & 70, the claimed TV system with downloadable features, comprising multiple receiving locations; a satellite transmitter for transmitting data with the features is met by Bacon, (col. 5, lines 2-10; col. 9, lines 24-35). The claimed multiple for receiving receivers for receiving the transmitted data, such that one of the receivers are located within each of a receiving location, wherein transmitted data includes an identifier identifying at least one of the receiving locations, is necessarily met by operation of Bacon which is enabled to transmit programming to a plurality of users, see col. 3, lines 18-30 & col. 10, lines 54-65.

The claimed memory associated with each of the receiving locations for storing data related to the features, such that the downloaded data is only stored when the receiver is properly addressed is met by Bacon, (col. 9, lines 25-33 & col. 10, lines 54-60). The claimed processor associated with each of the receiving locations coupled to the memory, wherein the processor



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uses the data to implement at least one of the features in at least one of the receiving locations, col. 7, lines 51-65 & col. 8, lines 31-53.

The instant claim additionally requires that the receiving apparatus are at least one of a TV, VCR or a VCR, whereas Bacon only discloses a receiving apparatus which receives and stores the downloadable features comprising a satellite receiver device, shown as external to the actual TV display, see Fig. 1 & col. 6, lines 15-50. Nevertheless, Isenberg discloses that a set-top-box device, which corresponds with the satellite receiver of Bacon, may be integrated within a viewer's display device, col. 2, lines 34-36. One of ordinary skill in the art at the time the invention was made, would have been motivated to modify Bacon, according to the disclosure of Isenberg, integrating a network terminal device within a TV, at least for the known desirable advantage of a more convenient and easily mobile receiving unit, which is more efficient for the user.

Considering claims 33, 37 & 49, Bacon discloses a remote control device 126, Fig. 2A; col. 6, lines 32-35.

Considering claims 34-35, 47-48 & 55, Bacon necessarily includes a TV screen 42,46 & 50 for displaying information related to at least one of downloaded features, Fig. 1; col. 7, lines 45-50.

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Considering claims 36 & 51, Bacon teaches the well-known technique of ordering features such as pay-per-view over a telephone, Fig. 2A; col. 9, lines 15-20.

Considering claims 38-39, 50 & 52-53, in Bacon the user is enabled to order features, (col. 7, lines 55-60; col. 8, lines 8-11; col. 16, lines 21-35).

Considering claim 40, Bacon transmits codes that enable a subscriber to interact with the terminal using a remote control, col. 3, lines 54-64.

Considering claim 46, the claimed method for providing a TV system with downloadable features corresponds with subject matter mentioned above in the rejection of claim 32, and is likewise analyzed.

Considering claims 56-57, see Bacon, col. 6, lines 15-45.

Considering claim 58, Bacon discloses an On-Screen display which assists the user in feature and program selection, col. 7, lines 40-50 & col. 8, lines 1-11.

Considering claim 59, the IR receiver 124 reads on the claimed subject matter, Fig. 2A; col. 6, lines 33-36 & col. 7, lines 62-65.

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Considering claim 65, the identifier in Bacon may at least identify a version of software code and the ID & location of the subscriber terminal, (col. 5, lines 59-65; col. 9, lines 25-45 & col. 10, lines 51-65).

### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 872-9314 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Brown M. Reuben whose telephone number is (703) 305-2399.  
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9314 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
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